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OFFICE OF PETITIONS

In re Application of :
O'Mahony and Gururaj :
Application No. 10/813,430 : DECISION REFUSING STATUS
Filed: March 31, 2004 : UNDER 37 CFR 1.47(a)
Attorney Docket No. 66396-153 :
:

This is in response to the petition under 37 CFR 1.47(a), filed September 14, 2004. Petitioner obtained a one-month extension of time to respond. Accordingly, the petition is timely filed.

The petition is dismissed.

Applicants are given TWO (2) MONTHS from the mailing date of this decision to reply, correcting the below-noted deficiencies. Any reply should be entitled "Request for Reconsideration of Petition Under 37 CFR 1.47(a)," and should address the deficiencies noted below, except that the reply may include an oath or declaration executed by the non-signing inventor. Failure to respond will result in abandonment of the application. Any extensions of time will be governed by 37 CFR 1.136(a).

The above-identified application was filed on March 31, 2004, without an executed oath or declaration. Accordingly, on June 14, 2004, the Office of Initial Patent Examination mailed a "Notice to File Missing Parts of Application," requiring an oath or declaration, the statutory basic filing fee and a surcharge for their late filing.

In response, on September 14, 2004, applicants filed the present petition, a Declaration of Facts of Brenda G. Cnudde, a declaration executed by one of the two joint inventors, a request for a one-

month extension of time to respond, and an authorization to charge any necessary fees.

In the Declaration of Facts, Ms. Cnudde stated that on June 25, 2004, she sent a letter to the nonsigning inventor, Manjula Gururaj, at 520 Mansion Court #102, Santa Clara, CA 95054, to review the patent application and to sign the Declaration and Power of Attorney and Assignment documents. Ms. Cnudde did not receive a response to the letter. Ms. Cnudde further stated that she obtained Ms.

Gururaj's last known address from the human resource department, and sent another letter to Ms. Gururaj at 480 Oak Grove Drive, Apt. 102, Santa Clara, CA 95054. The letter was returned and marked as "Return to Sender, Forwarding Order Expired." A copy of the returned envelope accompanies the present petition. On August 3, 2004, Ms. Cnudde call Ms. Gururaj at her last known phone number and left a message but Ms. Gururaj did not return the call. On August 4, 2004, Ms. Cnudde sent an email to Ms. Gururaj and asked her to contact Mr. Cnudde; however, no response was received.

A grantable petition under 37 CFR 1.47(a) requires: (1) proof that the non-signing inventor cannot be reached or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims and drawings); (2) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116; (3) the petition fee; and (4) a statement of the last known address of the non-signing inventor. Applicants lacks item (1) set forth above.

As to item (1), applicants failed to show that the inventor cannot be reached after diligent efforts. As previously stated, applicants explained that on July 22, 2004, Ms. Cnudde sent a letter to Ms. Gururaj at her last known address; however, the letter was returned and marked as "Return to Sender, Forwarding Order Expired." In the present petition, applicants did not set forth in detail what diligent efforts were made to obtain a current address for Ms. Gururaj. Accordingly, the record currently fails to demonstrate, with a documented showing, that a diligent effort was made to find or locate Ms. Gururaj so as to obtain her signature on the declaration, such that the declaration can be accepted under 37 CFR 1.47.

Where inability to find or locate a named inventor is alleged, a statement of facts should be submitted that fully describes the exact facts which are relied on to establish that a diligent effort was made to locate the inventor. A person having firsthand knowledge of the facts must sign the statement of facts, where at all possible. If attempts to obtain a forwarding address and to locate the non-signing inventor by other means such as through

E-mail, telephone, or the Internet continue to fail, then applicant will have provided the necessary proof required under 37 CFR 1.47 that the inventor cannot be reached. Applicants should submit documentary evidence such as the results of an Internet search for Ms. Gururaj's most current address. It is important that the forthcoming communication contain statements of fact as opposed to conclusions. If there is an express oral refusal, a statement from the person to whom that refusal was made should be made of record.

Further correspondence with respect to this matter should be addressed as follows and **to the attention of Christina Tartera Donnell, Senior Petitions Attorney:**

By mail: Mail Stop Petition
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P.O. Box 1450
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By FAX: (703) 872-9306
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Telephone inquiries related to this decision may be directed to the undersigned at (571) 272-3211.

Christina Tartera Donnell

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